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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|----------------------|-------------|----------------------|---------------------|------------------|
| 10/662,633 | 09/16/2003 | Franz Deitering | 11884/407601 | 9755 |
| 53000 | 7590 | 02/06/2009 | EXAMINER | |
| KENYON & KENYON LLP | | | KARDOS, NEIL R | |
| 1500 K STREET N.W. | | | | |
| WASHINGTON, DC 20005 | | | ART UNIT | PAPER NUMBER |
| | | | 3623 | |
| | | | MAIL DATE | DELIVERY MODE |
| | | | 02/06/2009 | PAPER |

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

| | | |
|------------------------------|------------------------|---------------------|
| Office Action Summary | Application No. | Applicant(s) |
| | 10/662,633 | DEITERING ET AL. |
| | Examiner | Art Unit |
| | Neil R. Kardos | 3623 |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) Responsive to communication(s) filed on 11 December 2008.
 2a) This action is **FINAL**. 2b) This action is non-final.
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) Claim(s) 1-11, 13, 21, 22 and 24-35 is/are pending in the application.
 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
 5) Claim(s) _____ is/are allowed.
 6) Claim(s) 1-11, 13, 21, 22 and 24-35 is/are rejected.
 7) Claim(s) _____ is/are objected to.
 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) The specification is objected to by the Examiner.
 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

| | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ . |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ . | 6) <input type="checkbox"/> Other: _____ . |

DETAILED ACTION

This is a **FINAL** Office Action on the merits in response to communications filed on December 11, 2008. Claims 1, 21, 24, 27, and 32-35 have been amended. Claims 12 has been cancelled. Currently, claims 1-11, 13, 21, 22, and 24-35 are pending and have been examined.

Response to Arguments

Applicant's arguments filed on December 11, 2008 have been fully considered but they are not persuasive. Applicant argues the following:

- (A) Havens does not disclose comparing “a class identifier with each user profile” as claimed. (see Remarks, pages 9-10).
- (B) Havens does not disclose the claimed feature of “extracting a segment” responsive to “an indicator of business performance.” (see Remarks, pages 10-11).

Applicant's arguments will now be addressed in turn:

- (A) **Havens does not disclose comparing “a class identifier with each user profile” as claimed.**

Regarding argument (A), Examiner notes that the argued limitation has been amended in the current response. Examiner has applied new art to this limitation below, rendering moot Applicant's argument regarding this limitation. Because the new grounds of rejection below is necessitated by Applicant's amendment to the claims, the finality of this Office Action is proper.

(B) Havens does not disclose the claimed feature of “extracting a segment” responsive to “an indicator of business performance.”

Regarding argument (B), Examiner respectfully disagrees. First, Examiner notes that the proper analysis under § 103 is whether the claimed invention would have been obvious to one of ordinary skill in the art after consideration of all the facts. *See MPEP 2141(III)*. Furthermore, prior art is not limited just to the references being applied, but includes the understanding of one of ordinary skill in the art. *See id.* Here, Examiner maintains that extracting a segment of survey results data responsive to an indicator of business performance would have been obvious to one of ordinary skill in the art after consideration of Havens in view of Sanders.

Havens discloses that survey data can be extracted and compared to benchmarks. (see figure 3: items 128-130; column 1: lines 14-22; column 6: lines 34-57; column 8: lines 10-25; column 9: lines 8-22). Havens also discloses that a user can select the survey data that is extracted. (see column 1: lines 48-50; column 2: lines 7-13; column 6: lines 39-42 and 49-53). Finally, Havens discloses that the purpose of such extraction and comparison is for a "knowledge worker productivity assessment" that is used to modify and improve productivity. (see column 1: lines 12-22; column 2: lines 3-13). Thus, the reference at least suggests to one of ordinary skill in the art that a user can select survey data to extract and analyze in response to low worker productivity. Furthermore, Havens discloses assessing worker productivity over a period of time. (see column 1: lines 27-29). A "period of time" is one of the claimed "indicators of business performance" (see claim 3); thus, Havens teaches an indicator of business performance by teaching a period of time.

Might (US 6,766,319) has been introduced to teach the amended claim limitations.

Might also teaches "extracting a segment" of survey data responsive to "an indicator of business performance." (see at least columns 17-18, disclosing extracting survey responses according to time periods, performing trend analyses, and automatically alerting users of worrisome trends).

Response to Amendment

Applicant's amendment to claim 1 is NOT sufficient to overcome the rejection under 35 U.S.C. § 101 set forth in the previous Office Action. Accordingly, this rejection has been reasserted below.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-11 and 13 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claim 1: Claim 1 is directed toward the statutory category of a process. In order for a claimed process to be patentable subject matter under 35 U.S.C. § 101, it must either: (1) be tied to a particular machine, or (2) transform a particular article to a different state or thing. *See In Re Bilski*, 88 U.S.P.Q.2d 1385 (2008); *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972). If neither of these requirements is met by the claim, the method/process is not patentable subject matter under § 101. Thus, to qualify as a statutory process under § 101, the claim should positively recite the

machine to which it is tied (e.g. by identifying the apparatus that accomplishes the method steps), or positively recite the subject matter that is being transformed (e.g. by identifying the material that is being changed to a different state). Nominal recitations of structure in an otherwise ineligible method fail to make the method a statutory process. *See Benson*, 409 U.S. at 71-72. Thus, incidental physical limitations such as insignificant extra-solution activity and field of use limitations are not sufficient to convert an otherwise ineligible process into a statutory one.

Here, the claimed process fails to meet the above requirements for patentability under § 101 because it is not tied to a particular machine and does not transform underlying subject matter. Applicant has amended one of the limitations of claim 1 to recite “determining each user of the target group having access to the E-survey by comparing, **by a computing device**, a class identifier with each user profile.” This recitation of structure is merely nominal because it occurs in an insignificant extra-solution step. It is not clear that a machine is used to carry out the claimed method steps (i.e. there is not a sufficient tie to a particular machine).

Claims 2-11 and 13: Dependent claims 2-11 and 13 are rejected for failing to remedy the deficiencies of the claims from which they depend.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-3, 5, 7-11, 13, 21-22, 24-32, and 34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Havens (US 5,909,669) in view of Sanders (US 6,411,936), and further in view of Might (US 6,766,319).

Claim 1: Havens discloses an automated business objective evaluation method, comprising:

- generating a target group of users for a survey, wherein each user of the target group has a user profile (see col. 2: ln. 7-13, disclosing limiting survey-based assessments to selected workers; col. 4: ln. 18-41, disclosing targeting workers, peers, managers, and supervisors; col 5: ln. 58-61; col. 6: ln. 4-17, disclosing worker profiles; col. 11: ln. 28-49);
- aggregating survey results data with other business data into a business information warehouse, wherein the other business data are acquired via means other than the survey (see figure 2: items 12-18; col. 6: ln. 18-57, disclosing aggregating survey results data with benchmark data)
- responsive to an indicator of business performance, extracting a segment of survey results data corresponding to the indicator (see col. 6: ln. 58 through col. 7: ln. 5; col. 7: ln. 22-57; col. 8: ln. 10-25; col. 12: ln. 17-27; col. 1: ln. 14-22 and 27-29)
- comparing the extracted segment to an aggregate set of survey results data (see col. 6: ln. 33-57; col. 8: ln. 10 through col. 9: ln. 22, describing the comparator; col. 13: ln. 38-55);

- identifying any survey results data from the extracted segment that statistically differ from responding results data from the aggregate set by a predetermined amount (see col. 7: ln. 36-49; col. 8: ln. 26-49; col. 9: ln. 9-43, disclosing identifying disparities with respect to a standard deviation);
- linking the identified statistically different survey results data to business key values in the business information warehouse (see col. 7: ln. 22-57; col. 8: ln. 26 through col. 9: ln. 43; Specifically, col. 9: ln. 23-43, disclosing linking disparities to productivity).

Havens does not explicitly disclose E-surveys. However, Examiner takes Official Notice that E-surveys were old and well-known in the art at the time the invention was made. Thus, the elements and their functions are known in the prior art, albeit in separate references (or in this case, the Havens reference and Official Notice). The difference between the claimed subject matter and the prior art rests not on any individual element or function, but on the combination itself. That is, in the substitution of E-Surveys as known in the art for paper surveys as disclosed by Havens. The simple substitution of one known element for another producing a predictable result renders the claim obvious.

Havens also does not explicitly disclose determining whether objectives of strategic enterprise management planning are being met. Presumably the worker productivity assessment described by Havens is undertaken in order to improve worker productivity, which would likely be an objective of a strategic management plan. Sanders discloses using surveys (see e.g. col. 13: ln. 6-15; col. 14: ln. 5-10) in conjunction with performance metrics (see e.g. col. 14: ln. 41-54) and key value drivers (see e.g. col. 12: ln. 28-57) in order to meet strategic planning

objectives (see e.g. col. 2: ln. 5-23; fig. 5: item 509; col. 13: ln. 45-49; col. 14: ln. 31-54; col. 15: ln. 4-17). Havens and Sanders both relate to improving a business through the use of surveys. Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use the methodology of Havens to determine whether strategic objectives are being met, as taught by Sanders. One of ordinary skill in the art would have been motivated to do so for the benefit of improving productivity and efficiency (see Sanders: col. 8: ln. 18-22).

Further, Havens does not explicitly disclose determining each user of the target group having access to the E-survey by comparing, by a computing device, a class identifier with each user profile. Might teaches this limitation. (see figures 4-5; column 3: lines 44-46; table 1; column 14: lines 1-19). It would have been obvious to one of ordinary skill in the art at the time the invention was made to use the methods taught by Might to control who has access to the surveys of Havens. One of ordinary skill in the art would have been motivated to do so for the benefit of obtaining only relevant survey responses.

Claim 2: Havens discloses wherein the indicator identifies an organizational unit of a business experiencing anomalous performance (see col. 7: ln. 22-57, disclosing segmenting parameters of surveys via numerical range; col. 8: ln. 26 through col. 9: ln. 8).

Claim 3: Havens suggests wherein the indicator identifies a period of time (see col. 1: ln. 27-29).

Claim 5: Havens discloses wherein the indicator is a key performance indicator (see col. 7: ln. 22-57, disclosing segmenting parameters of surveys including worker criteria and information criteria).

Claim 7: Havens discloses wherein the indicator is an employee satisfaction indicator (see at least col. 4: ln. 33-37).

Claim 8: Havens discloses wherein the aggregate set is survey results data for a business and the extracted segment is a portion of the aggregate set (see col. 6: ln. 18-57).

Claim 9: Havens suggests wherein the aggregate set is survey results data for a market in which the business participates (see col. 1: ln. 19-22; col. 6: ln. 18-57).

Claim 10: Havens discloses comparing the extracted segment of survey results data to historical data (see col. 6: ln. 33-39).

Claim 11: Havens discloses comparing the extracted segment of survey results data to external benchmarks (see col. 6: ln. 18-57).

Claim 13: Havens discloses wherein the business key values are at least one of sales revenues, turn over rates, profit statistics, cost statistics, quality statistics, customer satisfaction rates and illness rates (see figure 1, disclosing quality statistics and customer satisfaction rates).

Examiner also notes that Sanders discloses revenues and cost statistics as key value drivers (see figure 5: items 519-521).

Claims 21, 24, 27, and 30: Claims 21, 24, 27, and 30 are substantially similar to claim 1, except that they are directed to a system. Havens discloses such a system (see e.g. figure 2; col. 10: ln. 9-22). Thus, claims 21, 24, 27, and 30 are rejected under similar rationale as claim 1.

Claim 22: Havens does not explicitly disclose wherein the output manager is to permit access to the generated result based on pre-determined access rights. However, Examiner takes Official Notice that it was well-known in the arts at the time the invention was made to grant permission to information based on access rights (e.g. via a login password). Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to protect the information reported in Havens by using pre-determined access rights as is well-known in the art. One of ordinary skill in the art would have been motivated to do so for the benefit of increased security.

Claim 25: Claim 25 is substantially similar to claim 8 and is rejected under similar rationale.

Claim 26: Claim 26 is substantially similar to claim 9 and is rejected under similar rationale.

Claim 28: Claim 28 is substantially similar to claim 10 and is rejected under similar rationale.

Claim 29: Claim 29 is substantially similar to claim 11 and is rejected under similar rationale.

Claim 31: Claim 31 is substantially similar to claim 13 and is rejected under similar rationale.

Claims 32 and 34: Claims 32 and 34 are substantially similar to claims 3 and 5, respectively, and are rejected under similar rationale.

Claims 4, 6, 33, and 35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Havens in view of Sanders and Might, and further in view of Nelson (US 7,233,908).

Claims 4 and 6: Havens, Sanders, and Might do not explicitly disclose wherein the indicator identifies a geographic region (claim 4) or customer satisfaction (claim 6).

Nelson discloses wherein the indicator identifies a geographic region (see col. 5: ln. 60-62, disclosing comparing regions; figure 9: item 292; col. 6: ln. 6, disclosing comparing satisfaction by site) and wherein the indicator is a customer satisfaction indicator (see figures 8 and 11).

Havens, Sanders, Might and Nelson are all directed to conducting surveys for evaluative purposes. Thus, it would have been obvious to one of ordinary skill in the art at the time the

invention was made to use the indicators taught by Nelson for the purpose of comparative evaluations as taught by Havens. One of ordinary skill in the art would have been motivated to do so for the benefit of increased flexibility and adaptability in the comparison process.

Claims 33 and 35: Claims 33 and 35 are substantially similar to claims 4 and 6, respectively, and are rejected under similar rationale.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Neil R. Kardos whose telephone number is (571) 270-3443. The examiner can normally be reached on Monday through Friday from 9 am to 5 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Beth Boswell can be reached on (571) 272-6737. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Neil R. Kardos
Examiner
Art Unit 3623

NRK
2/4/09
/Jonathan G. Sterrett/
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